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Marco Scibora

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BRIGGS AND MORGAN P.A.
2200 IDS CENTER
80 SOUTH 8TH ST
MINNEAPOLIS, MN 55402

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCO SCIBORA

Appeal 2008-3891
Application 10/090,906
Application Technology Center 3600

Decided: November 25, 2008

Before, HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 10, 19, 20 and 21. Claims 1-9, 11-18, 22-29 are withdrawn from consideration.

We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims an apparatus in which retail shoppers are able to "mark" music CD(s), DVD videos, games, etc. while sampling a music CD or viewing DVD videos and games. (Specification 2:2-4)

Claim 10, reproduced below, is representative of the subject matter on appeal.

10. Apparatus for allowing a consumer to digitally mark portions of media content and later retrieve the marked portions uniquely keyed to that consumer, comprising:

- a. storage for storing the media content;
- b. a server computer accessing the media content storage;
- c. a workstation interacting with the server computer to allow the consumer to sample portions of the stored media content;
- d. a plurality of portable identification means identifying the consumer, separate from the server and the workstation and the sampled portions, and including identifying indicia unique to each instance of the portable identification means, the portable identification means being presented to the workstation; and
- e. an array containing references to the identifying indicia received from the workstation and indicia keyed to selected instances of the sampled portions of the stored media content.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Ritz	US 2003/0109944 A1	Jun. 12, 2003
Kaplan	5,237,157	Aug. 17, 1993

The following rejection is before us for review.

1. The Examiner rejected claims 10, 19, 20, and 21 as obvious under 35 U.S.C. § 103(a) over Ritz in view of Kaplan.

ISSUE

Has the Appellant shown that the Examiner erred in rejecting claims 10, 19, 20, and 21 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Ritz in view of Kaplan on the grounds that it would be obvious to use the identification bar code on the access card disclosed in Kaplan as a means for identifying the user in Ritz?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Examiner found that Ritz discloses
 - ...a. storage for storing the media content (FIG 1); b. a server computer accessing the media content storage (FIG 1); c. a workstation interacting with the server computer to allow the consumer to sample portions of the stored media content (FIG 1); [and that] Ritz teaches

collecting identifying information from a user in order to track their usage habits... . (Answer 3).

2. The Examiner found that Ritz does not

...specifically mention that the identifying information is received on a portable identification means. Kaplan teaches providing a barcode unique to the user to identify the user during a session (col. 5, l. 30-40). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Ritz, identifying information received on a portable identification, because this would allow for quick identification of a user who is not using their own personal device and allowed access to the previews program. (Answer 3, 4).

3. Ritz discloses a registration process whereby

[t]he relationship of end users 500 with the service provider/platform 100 may begin with a registration process, in some embodiments. End-users 500 may register with platform 100 through hub site 101. For example, with reference to FIG. 2, an end user may be presented with an offer 210 (e.g., sent via electronic mail or presented on a web page via a pop-up window or other advertisement) to subscribe to the service. Registration with the service may include, among other things, providing end user identification information 211 and billing information 212, setting a preferred broadcaster 214 (e.g. a favorite radio or TV station), providing information that indicates a usual locality 216 (e.g. a zip code), indicating a preferred type of media player 215 (e.g. CD or .mp3), indicating a preferred type of audio clip player 218 (e.g. RealPlayer), and/or indicating a preferred user device 220. End user 500 may be required

to purchase a subscription for the inventive service (e.g. \$XX.XX per a certain number of tracks selected per month).

4. Ritz discloses that once an end user registers with the platform 100 (Ritz, ¶[0020],)

... a consumer, while browsing in a store, scans the UPC code on the back of several CD jewel boxes. The codes are then uploaded to platform 100 via hub site 101 via a workstation connected to the Internet. The codes may be uploaded automatically upon scanning if the scanner is an Internet-connected device. The codes may also be uploaded automatically upon synching a code storage device with an device connected to the Internet upon navigation to hub site 101. Regardless of the type of upload procedure, the uploaded codes are stored, in the preferred embodiment, in platform 100.

(Ritz, ¶[0021]).

5. Ritz discloses matching data submitted by the end user at registration with suggestions the service provider makes to the user based on the registration data, e.g., "...the end user may have indicated a zip code with platform 100 upon registration. In this embodiment, the pull down menu 401 might contain broadcast stations associated with the zip code entered." (Ritz, ¶[0019]).

6. Ritz discloses using, *inter alia*, a scanning device to allow a user to input codes and other information into the system. (Ritz, ¶[0017]).

7. Ritz discloses "[i]t would be beneficial to combine the bar code scanning and other coding technology and web service application technology (in particular,

as it relates to music applications) in order to create media upon which a customized selection of audio tracks are recorded.” (Ritz, ¶[0003]).

8. Kaplan discloses:

[e]ach customer can complete a brief membership application which asks for basis demographic information, general music listening preferences and buying habits and an access card will then be generated for that subscriber. Each subscriber will have a barcode on their access card which will immediately identify them when beginning a session on the kiosk station 10. The subscriber identification can be further interfaced with the music store cash register so that with each music purchase following CD preview, the transaction will be identified as a kiosk-related sale.

PRINCIPLES OF LAW

The patentably consequential weight to be given limitations appearing in a preamble depends on whether, after careful consideration of the whole claim, the preamble limits the claim. “In considering whether a preamble limits a claim, the preamble is analyzed to ascertain whether it states a necessary and defining aspect of the invention, or is simply an introduction to the general field of the claim. In *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951), the court aptly described the inquiry as whether the preamble is ‘necessary to give life, meaning and vitality to the claims or counts.’” *On Demand Machine Corp. v. Ingram Industries, Inc.*, 442 F.3d 1331, 1343 (Fed. Cir. 2006).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a

person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine.” *Id.* at 1739. “In *United States v. Adams*, ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1739-40. “*Sakraida and Anderson’s-Black Rock* are illustrative – a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 1740.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in

the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

ANALYSIS

We affirm the rejection of claims 10, 19, 20, and 21.

The Appellant does not provide a substantive argument as to the separate patentability of claims 19, 20 and 21. Therefore, we address only claim 1. We thus also affirm the rejections of claims 19, 20 and 21 since Appellant has not challenged such with any reasonable specificity (*see In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987)).

The Appellant argues “Ritz does not indicate what means could be used for identifying a user. Thus, Ritz does not disclose a plurality of portable identification means identifying the consumer separate from the server and the workstation and the sampled portions.” (Appeal Br. 4). That argument is not well

taken because the Appellant is attacking the references individually when the rejection is based on a combination of Ritz and Kaplan, and the Examiner relies on Kaplan, and not Ritz, to teach a portable identification means (FF 2,8). *See In re Keller*, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58, 159 USPQ 725, 728 (CCPA 1968). This point aside, Ritz discloses registering the end user with the service provider (FF 3), and thus Ritz discloses a means for identifying a user. Furthermore, Ritz discloses using the identification data submitted by the end user at registration to match suggestions the service provider makes to the user based on the registration data whereby the registration data is used by the service provider to identify the user and then tie suggested products to the user (FF 5).

The Appellant seeks credit for the preamble of claim 10 as a limitation reciting “for allowing a consumer to digitally mark portions of media content and later retrieve the marked portions uniquely keyed to that consumer....” (Appeal Br. 5). However, when claim 10 is considered as a whole, it becomes evident that the preamble is simply an introduction to the general field of the claim. Nothing in the ensuing body portion of claim 10 makes reference to later retrieving marked portions of media so as to breathe life and breath into these preamble terms. In light of the breadth of the claim, the Appellant’s argument is not persuasive as to error in the rejection.

Notwithstanding, even if these preamble terms were integrated into the body of claim 10 enough to be creditable as limitations, we conclude that a person with ordinary skill in the art would understand that the registration data in Ritz which

ties suggested products to the user identification (FF 3,4,5), would similarly allow the hub site 101 to later retrieve the selections previously uploaded to it by using the identification data of the user to associate the selections with the user.

Finally Appellant argues that “[f]urther, there is no motivation disclosed in Ritz to make such identifying information portable. As stated above, the motivation to combine references must be found in the prior art. If not found in the prior art, the Examiner must supply a cogent reason for making the combination, not based on the applicant's disclosure.” (Appeal Br. 5). First, to the extent Appellant is looking for an explicit motivation, suggestion, or teaching in the art, this rigid test has been foreclosed by the Supreme Court’s holding in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). In *KSR*, the Court characterized the teaching, suggestion, motivation test as a “helpful insight” but found that when it is rigidly applied, it is incompatible with the Court’s precedents. *KSR*, 127 S. Ct. at 1741. The holding in *KSR* makes clear that it is no longer absolutely necessary to find motivation in the references themselves. *See KSR*, 127 S. Ct. at 1741.

Second, Ritz encourages the use of bar code scanning to create media based on custom selection of audio tracks (FF 7), but does not use bar codes in connection with user identification of the custom selections (FF 2). Kaplan discloses registering a user for use in a music transfer application, and then assigning a bar code symbol connected to that user registration to allow the user access the system and to identify the user to the system (FF 8). Thus, the need addressed by Ritz is answered by Kaplan’s use of bar codes to identify the user in custom music transfer situations. “Under the correct analysis, any need or problem

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known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR* at 1742. Appellant’s argument is thus not persuasive as to error in the rejection.

CONCLUSIONS OF LAW

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 10, 19, 20, and 21 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Ritz in view of Kaplan on the grounds that it would be obvious to use the identification bar code on the access card disclosed in Kaplan as a means for identifying the user in Ritz.

DECISION

The decision of the Examiner to reject claims 10, 19, 20 and 21 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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BRIGGS AND MORGAN P.A.
2200 IDS CENTER
80 SOUTH 8TH ST
MINNEAPOLIS, MN 55402